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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/369,391	08/06/99	ABELOW D	03058/004002

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EXAMINER	
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ART UNIT	**PAPER NUMBER**
2761	8

DATE MAILED: 09/12/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/369,391	ABELOW, DANIEL H.	
	Examiner	Art Unit	
	Thomas A. Dixon	2761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

1)☒ Responsive to communication(s) filed on *17 July 2000* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *48-72* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *48-72* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)☐ All b)☐ Some * c)☐ None of the CERTIFIED copies of the priority documents have been:

1.☐ received.

2.☐ received in Application No. (Series Code / Serial Number) _____ .

3.☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *1, 5* .
18) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other: .

DETAILED ACTION

1. The substitute specification is acceptable.

2. The objections and rejections of the previous action are withdrawn in view of applicant's amendment.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 48-72 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-48 of U.S. Patent No. 5,999,908. Although the conflicting claims are not identical, they are not patentably distinct from each other because a system for storing a repository of value information, determine based upon triggers indicated by a customer set preferences when value information would be useful, in response to the determining, distribute the value information to the user would be included as necessary to perform the invention.

Specification

5. The abstract of the disclosure is objected to because it is too long.

Correction is required. See MPEP § 608.01(b).

6. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> **The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.**

7. Claims 48-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, Claim 48, line 2 ends with a comma not a semi-colon, line 6 ends without any punctuation and line 18 ends with a comma, and it is unclear if there are

additional limitations to the claims, and therefore, renders the claim indefinite. Also, line 8, the phrase "as perhaps" renders the claim indefinite.

Claims 63, 64, and 65 have no punctuation, it is unclear if there are additional limitations to the claims, and therefore, render the claims indefinite.

8. Claims 67-71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the term "large numbers of independent users" in claim 67, line 2 is a relative term which renders the claim indefinite. The term "large numbers" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> **A person shall be entitled to a patent unless –**
>
> **(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

9. Claims 67, 69 are rejected under 35 U.S.C. 102(b) as being anticipated by Kurland et al (4,603,232).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 67-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurland et al (4,603,232) as applied to claim 67 above, and further in view of Frost (5,041,972).

As per Claim 67.

Kurland et al ('232) discloses a digital medium storing information generated by large numbers of independent users about the value of products, services, software or information, the medium being coupled to an electronic communication network, see Column 4, line 61 – Column 5, line19.

Kurland et al ('232) does not disclose interchange of new value information from the users to the digital medium and of stored value information from the medium to the users.

Frost (5,041,972) teaches users generating new value information interactively while using the stored value information, see Column 4, lines 34 – 50, for the benefit of selecting a set of attributes for market research which achieves the highest level of discrimination for each consumer interviewed.

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify the invention of Kurland ('232) to allow the users to generate new value information interactively while using the stored value information as taught by Frost ('972), for the benefit of selecting a set of attributes for market research which achieves the highest level of discrimination for each consumer interviewed.

As per Claim 68.

Kurland ('232) discloses all the limitations of Claim 67.

Kurland ('232) does not disclose the users generate the new value information interactively while using the stored value information.

Frost (5,041,972) teaches users generating new value information interactively while using the stored value information, see Column 4, lines 34 – 50, for the benefit of selecting a set of attributes for market research which achieves the highest level of discrimination for each consumer interviewed.

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify the invention of Kurland ('232) to allow the users to generate new value information interactively while using the stored value information as

taught by Frost ('972), for the benefit of selecting a set of attributes for market research which achieves the highest level of discrimination for each consumer interviewed.

As per Claim 69.

Kurland ('232) discloses all the limitations of Claim 67.

Kurland ('232) further discloses digital filters configured to identify patterns of sources of value information and fetch the identified information over the network, see Column 5, line 20 – Column 6, line 41.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

Claims 48-66 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Claims 70-71 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim 72 would be allowable if rewritten or amended to overcome the double patenting rejection(s) under 35 U.S.C. 101, set forth in this Office action.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

4,964,077 to Eisen teaches a help system which tracks user interactions, determines a skill level and adjusts the system interaction to match the user skill level,

WO 94/03865 to Abelow is the closest foreign prior art.

Shoenbrun "Easynet: What has become of the small Giant" discloses a server storing a repository of value database, and user set preferences for retrieval of information, but does not disclose the system as claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Friday 7 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Voeltz can be reached on (703) 305-9714. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-9051 for regular communications and (703) 305-9051 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9714.

TAD
August 31, 2000

EMANUEL TODD VOELTZ
SUPERVISORY PATENT EXAMINER
GROUP 2700